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IN THE

**Supreme Court of the United States**

OCTOBER TERM, 1947.

REYNOLDS METALS COMPANY, PETITIONER,

v.

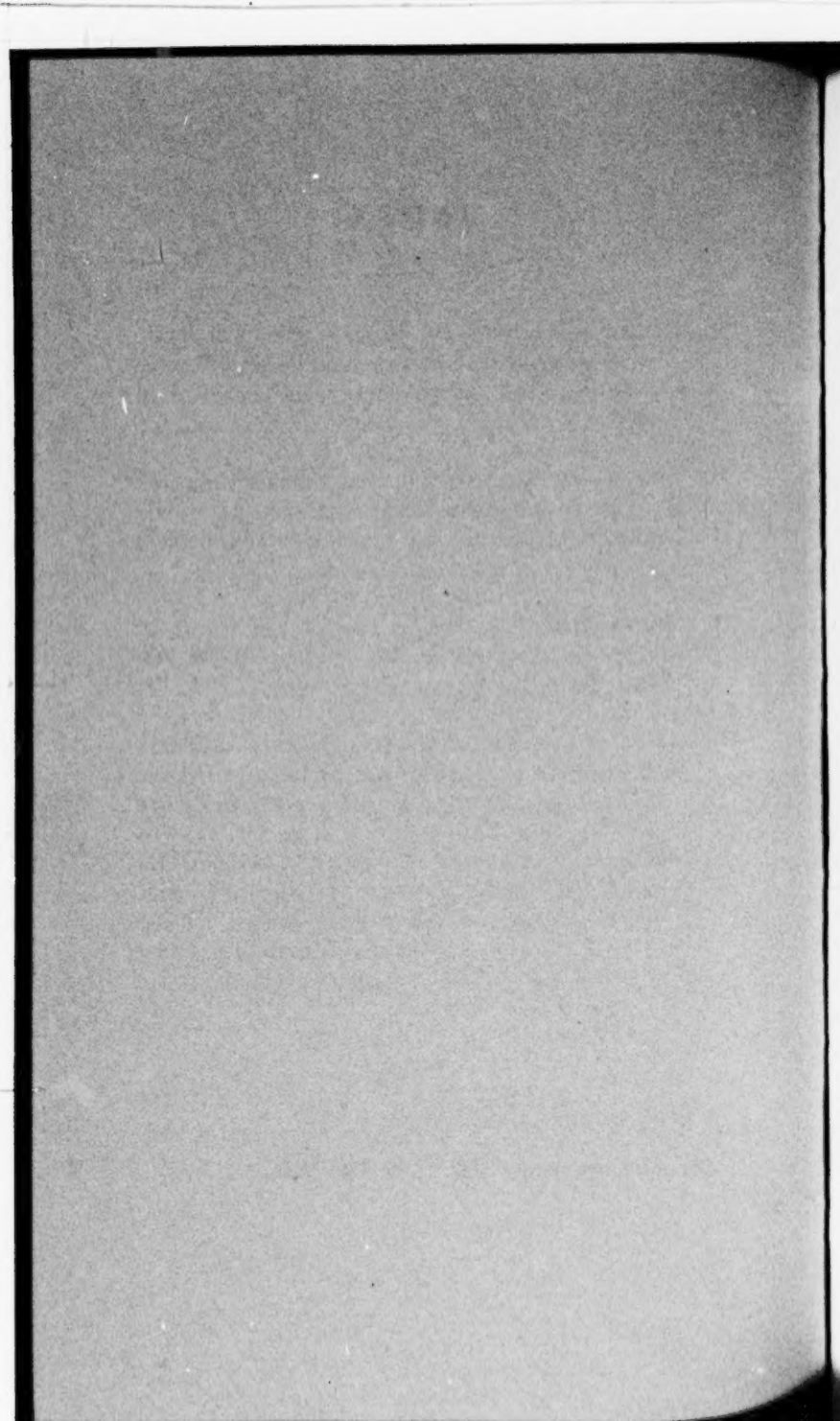
C. D. SKINNER AND LEO C. BRADLEY, RESPONDENTS.

On Petition for Writ of Certiorari to the United States Circuit  
Court of Appeals for the Sixth Circuit.

**PETITIONER'S REPLY TO RESPONDENTS' BRIEF.**

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## INDEX.

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	PAGE
I. Respondent ignores the doctrine upon which this case was decided and its inevitable effect in creating such serious error as occurred in this case .....	1
II. The doctrine asserted by the Circuit Court of Appeals affects a large class of the public and runs counter to the law laid down by this Court .....	2
III. The doctrine asserted by the Circuit Court of Appeals resulted in holding petitioner for use of an expired patent structure.....	3
IV. As to one patent the Circuit Court of Appeals discussed certain prior art, but gave no effect to limitations in the claims forced by prior art	4
V. The metes and bounds of a patent cannot be determined solely by the specifications and drawings; and the doctrine asserted by the Circuit Court of Appeals deprives a large class of the public of a positive right.....	4

### CASES.

<i>I. T. S. Co. vs. Essex Co.</i> .....	3
<i>McClain vs. Ortmyer</i> , 141 U. S. 419, 424.....	4



No. 797.

# Supreme Court of the United States

OCTOBER TERM, 1947.

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REYNOLDS METALS COMPANY,

*Petitioner,*

*versus*

C. D. SKINNER and LEO C. BRADLEY,

*Respondents.*

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On Petition for a Writ of Certiorari to the United States  
Circuit Court of Appeals for the Sixth Circuit.

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## PETITIONER'S REPLY TO RESPONDENTS' BRIEF.

That there is no substance in respondents' opposition to the grant of Writ of Certiorari in this case is plain from the following:

### I.

Respondents admit that the patent royalty obligation of petitioner was to pay royalties on

"all extrusion produces made in accordance with or embodying the inventions disclosed and claimed in any such patent"

Yet respondents do not contend that either court below gave any effect to the patent claims, or to limitations therein because of prior art, or to claims cancelled because of prior art.

The error of the Circuit Court of Appeals is thrown into high light by its treatment of patent No. 2,176,365 (Opinion, R., p. 647). The Court prefaced its treatment by the following doctrine:

“Since the issue is not one of infringement, we are not concerned with the prior art . . . The case is before us on the applications, drawings and specifications which reveal the inventive conceptions not limited by the rules applicable in infringement cases” (R., p. 646).

The Circuit Court of Appeals held, on such doctrine, that although petitioner had discontinued use of all of the patent claims it was liable for royalties for use of “the two story feature of the device stressed in the specification as being novel and patentable”. This “two story feature” is not covered by any of the patent claims. Petitioner had pointed out to the Court that a claim therefor was rejected on prior art and then limited by amendment to a shearing means combination never used, or contended to have been used, by petitioner.<sup>1</sup>

Petitioner was held to be obligated for royalties not for the use of any claim of said patent, but for the use of subject matter denied respondents because of rejection by the Patent Office on prior art.

## II.

This asserted doctrine of the Circuit Court of Appeals affects the entire class of patent assignees under royalty

<sup>1</sup> Original claim 23 (Deft's Exh. Vol. 1, p. 408), rejected on prior art. The Examiner ruled: “In any case the pit in the reference may be considered to be a lower floor, while the parts on base 2 may be considered to be an upper floor. In any case, the difference is not one of invention” (Deft's Exh. Vol. 1, p. 413). Respondents then limited the claims to include the special shearing means, never used by petitioner (Deft's Exh. Vol. 1, p. 416).

contracts. Resulting error such as in this case is inevitable under any doctrine that in a suit for patent royalties against a member of such class or any class of the public, the patent claims need be given no effect, and the invention determined solely from the patent specifications and drawings.

Such doctrine is directly counter to the principles of law laid down by this Court, that the patent **claims** measure the invention, that they must be read in the light of the prior art and rejected claims, and that no part of the prior art can be taken from the public domain. Specifications and drawings of a patent cannot be accepted as defining the metes and bounds of the invention.<sup>2</sup> (*I. T. S. Co. vs. Essex Co.*, 272 U. S. 429.)

### III.

Respondents make the bald statement that neither court below required petitioner to pay royalties for the use of a tapered die and its tapered enclosure as disclosed in an expired patent. Respondents ignore the admitted simple tapering of petitioners' dies with a corresponding tapered enclosure or "keeper ring", and that respondents' attempt to secure patent claims for such arrangement was rejected by the Patent Office because of a patent which expired before the Complaint herein.

In petitioner's briefs before both courts it was pointed out that the respondents' patent claims specified, and were limited to, a combination including a tapered base block, a construction never used or contended to have been used by petitioner. It was pointed out in said briefs that the file wrapper in evidence showed that the Patent Office had

<sup>2</sup> Respondents contend that the Circuit Court of Appeals applied the law laid down by this Court in *Eclipse Bicycle Co. vs. Farrow*, 199 U. S. 581. Respondents and the Circuit Court of Appeals grossly misinterpret that case. It has no bearing here.

rejected claims for the tapered die and enclosure *per se*, on patent to Clark, No. 1,574,792 of March 2, 1926. That patent obviously expired March 2, 1943. Respondents cancelled said rejected claims. Both courts nevertheless disregarded such disclaimer by respondents, and petitioner was held liable for royalties for the use of the tapered die and enclosure expedient of the Clark expired patent, and not for the invention covered by respondents' patent claims.

#### IV.

Respondents lay stress on the consideration by the Circuit Court of Appeals of certain prior art as to **one** of the respondents patents which related to an extrusion die. **But the Court utterly failed to apply the limitations in the claims of respondents said patent, which limitations had been forced by the prior art.** It is quite evident that, as was the case with the remaining patents, the erroneous doctrine of the Court was applied and the claims were not given any effect. Petitioner did not come within any one of them.

#### V.

In *McClain vs. Ortmyer*, 141 U. S. 419, 424, this Court said:

**"The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery' is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them. . . ."**

Are patent assignees, simply by paying consideration in the form of royalties, to be deprived of this positive right



of the public? How can they determine the extent of their obligations except by the patent claims? If the patent specifications, and not the claims, prescribe the metes and bounds, when sued for royalties they may be held for the use of old devices and those of expired patents, which was the result in the present case. The entire class of patent assignees under royalty contracts is affected.

It is believed that this important question of law is of substantial public interest, and warrants review by *certiorari*.

Respectfully submitted,

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